

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion and present amendment, is respectfully requested.

Claims 24-49 are pending in the present application, Claims 24-49 having been added, and Claims 1-6, 10-13, 15, and 19-23 having been canceled without prejudice or disclaimer. Support for new Claims 24-49 is found, for example, at page 27, lines 20-22, page 32, lines 5-20, and page 34, line 18 to page 35, line 16 of the originally filed specification, and Applicant's Figs. 2 and 16. Applicant respectfully submits that no new matter is added.

In the outstanding Office Action, Claims 1-6 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 22 of copending application 11/396,685; Claims 1-6, 10, 12, 13, 15, and 19-23 were rejected under 35 U.S.C. §103(a) as unpatentable over Kakutani (U.S. Patent No. 6,817,794) in view of Ogura et al. (U.S. Patent No. 5,608,494, hereinafter Ogura); and Claims 2 and 11 were rejected under 35 U.S.C. §103(a) as unpatentable over Kakutani in view of Ogura, and further in view of Yoshino et al. (U.S. Patent No. 4,944,031, hereinafter Yoshino).

Applicants respectfully submit that the double patenting rejection is moot in view of the present amendment.

The outstanding grounds of rejection are moot in view of the cancellation of Claims 1-6, 10-13, 15, and 19-23.

New Claim 24 patentably distinguishes over Kakutani, Ogura, and Yoshino. Claim 24 recites,

An image forming apparatus comprising:

a storage unit configured to store user-input setting information that indicates when not to print with a substitute recording medium when a size of a recording medium indicated by a print instruction is unavailable;

a processor configured to determine whether or not to use the substitute recording medium based on the user-input setting information, and to execute the print instruction by automatically changing a size of the recording medium indicated by the print instruction to the size of the substitute recording medium when the size of the recording medium indicated by the print instruction is not available and the user-input setting information causes the processor to print with the substitute recording medium; and

a printing unit configured to print an image on the recording medium or the substitute recording medium as indicated by the processor.

Kakutani describes a “printer which selects one of a plurality of trays, and prints on paper stored in the selected tray based on printing job data specifying a paper size, a paper type, and a tray from a host device.”<sup>1</sup> For one embodiment, Kakutani states:

For example, as shown in FIG. 1, in the tray set table 10, a size A' and a type X' are set in a tray 1, and a size A" and a type X" are set in a tray 2. Accordingly, in the case where the paper size and paper type of specifying information included in the printing job data from the host device are A, X, respectively, the size and type of the papers stored in the trays 1, 2 do not agree with those of the specifying information. However, in the alternative table 20 of the printer, for example, if the paper size A and the paper type X are registered corresponding to the tray 1, the printer does not become in the disagreement error condition, and prints by use of the papers stored in the tray 1 in accordance with the alternative table 20.<sup>2</sup>

However, Kakutani does not describe the alternative table as storing “user-input setting information that indicates ***when not to print with a substitute recording medium when a size of a recording medium indicated by a print instruction is unavailable.***”

Kakutani does not register, in the alternative table, a setting (or information) indicating not to use the substitute paper size. Kakutani merely describes whether or not to make a registration in the alternative table.

---

<sup>1</sup> Kakutani, col. 1, lines 6-10.

<sup>2</sup> Kakutani, col. 5, lines 16-27.

Ogura describes an image forming apparatus that counts a number of copying operations performed for each user.<sup>3</sup> There is no disclosure or suggestion in Ogura of “user-input setting information that indicates *when not to print with the substitute recording medium when the size of a recording medium indicated by the print instruction is unavailable.*”

Yoshino describes an image forming apparatus (Fig. 1) which uses a menu sheet (Figs. 3A and 3B) to select operational conditions (copy number, copy size, magnification, etc.). There is no disclosure or suggestion in Yoshino of “user-input setting information that indicates *when not to print with the substitute recording medium when the size of a recording medium indicated by the print instruction is unavailable.*”

In view of the above-noted deficiencies, a person of ordinary skill in the art could not properly combine Kakutani, Ogura, and Yoshino to arrive at the invention defined by Claim 1.

In view of the above-noted comments, Applicants respectfully submit that amended Claim 1 (and any claims dependent thereon) patentably distinguish over Kakutani, Ogura, and Yoshino, taken alone or in proper combination. Claims 34 and 42 recite elements analogous to those of Claim 24. Applicant respectfully submits that Claims 33 and 40 (and any claims dependent thereon) patentably distinguish over Kakutani, Ogura, and Yoshino, for at least the reasons stated for Claim 24.

---

<sup>3</sup> Ogura, abstract.

Consequently, in light of the above discussion and present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.

---

James J. Kulbaski  
Attorney of Record  
Registration No. 34,648

Joseph Wrkich  
Registration No. 53,796

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 07/09)  
1876245\_2.DOC